

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

ATOMP004

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10773755

Filed

Feb. 6, 2004

First Named Inventor

Brian Y. Lim

Art Unit

1791

Examiner

R.J. Kemmerle III

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Melvin D. Chan/

Signature

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Melvin D. Chan

Typed or printed name

☒ attorney or agent of record.

Registration number 39, 626

408-701-0035

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

July 24, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 1.16. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

United States Patent and Trademark Office

Application No.: 10/773,755
Confirmation No.: 4021
Customer No.: 51111
Docket No.: ATOMP004

Commissioner for Patents
POB 1450
Alexandria, VA 22313-1450

Reasons for Pre–Appeal Brief Review Request

Dear Commissioner:

Applicants request a pre–appeal brief conference review because the rejections of record are clearly based on legal and factual error. The following is a summary of reasons, for which details can be found in the record at, among other places, pages 2–7 of the March 11, 2009 response.

Claim 21

The examiner’s section 102(b) rejection of claim 21 is improper as discussed on pages 2–4 of the response: Beshoory does not show or suggest “*a housing . . . the second end of the housing comprises no openings*,” as recited in claim 21. Rather, tube 40 (figure 2) has openings at each end.

In the final office action, the examiner states that he:

[C]onsider[s] the entire system a ‘housing’ (tube plus bell jar).

Page 7.

The examiner has completely distorted Beshoory by disassembling it, cherry-picking *two different housings* (i.e., tube 40 and bell jar 21), and somehow joining them to make his own housing which bears no resemblance to Beshoory and cannot be used as Beshoory originally intended. This is not proper. The claim recites limitations for “a housing,” i.e., *one* housing. With Beshoory, the examiner *attempts to read two housings as one housing*.

For at least this reason, claim 21 should be allowable.

Further, even accepting the examiner's housing the claim would still be allowable. The examiner's housing has openings at both ends. According to the examiner, the right end of his housing is made of bell jar 21. Bell jar 21 (figure 2) is shown in dashed lines to indicate it reflects prior art bell jar 10 (figure 1). Column 1, lines 65–68. Bell jar 21, like bell jar 10, has an opening at its right-most end so that an inert gas can pass from right to left and expel the treat gas through exit 44. Column 2, lines 57–60. The treat gas, along with reaction products and contaminants, are expelled so that they do not ruin later measurements. So, there is an opening at the right-most end of the examiner's housing.

For at least this additional reason, claim 21 should be allowable.

At page 7 in the office action, the examiner reasons that because Beshoory notes the inert gas can enter housing 20, this means there is no opening at the right-most end of bell jar 21. Yet, the examiner ignores the very reason why the gas is able to enter housing 20.

The gas can enter housing 20 *because there is an opening at the right-most end of bell jar 21*. The gas passes through bell jar 21, and enters housing 20 via an opening on a right side of the housing which opens into the bell jar. Other than this opening on the housing, there are no other openings for the gas to enter. Therefore, the gas must enter housing 20 through this opening. Since this opening opens into bell jar 21, the bell jar, in turn, must have an opening (i.e., the opening at its right-most end) for the gas.

For at least any one of these reasons, claim 21 should be allowable. Claims 42, 50, 63, 66, 70, 72, 76, and 78 should be allowable for at least similar reasons as claim 21. See section 4 of the March 11, 2009 response for details. Claims 22–25, 43–49, 51–58, 64–65, 68–69, 71, 73–75, 77, 79–88 should be allowable for at least being dependent upon allowable base claims. See sections 5.1–5.5.

Claims 69, 74, 80, and 85

Additionally, dependent claims 69, 74, 80, and 85 recite “wherein the housing is made wholly of one material.” The examiner, having construed “the entire system a ‘housing’” to reject, for example, claim 21, now construes “housing” to “only . . . be the tube (40) of Beshoory” to reject claim 85. Pages 7–8 Final Office Action.

However, *the “housing” recited in claim 85 refers to the “housing” recited in claim 21* as claim 85 is dependent on claim 21. Having construed “housing” to be one thing (i.e., “entire

system”), the examiner cannot now construe “housing” to be a different thing (i.e., “only . . . tube (40)”) because the language of claim 85 makes clear that it recites a limitation of the housing element recited in claim 21.

For at least this reason, claims 69, 74, 80, and 85 should be allowable.

Applicants believe all pending claims are allowable.

Respectfully submitted,

Aka Chan LLP

/Melvin D. Chan/

Melvin D. Chan

Reg. No. 39,626

Aka Chan LLP
900 Lafayette Street, Suite 710
Santa Clara, CA 95050
Tel: (408) 701-0035
Fax: (408) 608-1599
E-mail: mel@akachanlaw.com